



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: **SUZUKI, Junichiro, et al.**

Group Art Unit: 1772

Serial No.: 10/757,453

Examiner: **C. P. BRUENJES**

Filed: **January 15, 2004**

**P.T.O. Confirmation No.: 5057**

For: **AUTOMOTIVE FUEL HOSE**

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

February 27, 2007

Sir:

In response to the Examiner's Answer mailed **January 10, 2007**, consideration of the following remarks is respectfully requested.

**Remarks/Arguments** begin on page 2 of this paper.

U.S. Patent Application Serial No. **10/757,453**  
Reply Brief filed February 27, 2007  
Reply to OA dated January 10, 2007

### **REMARKS**

This Reply Brief responds to the arguments made in Headings (9) and (10) of the Examiner's answer.

Heading (9): The Examiner summarizes the one ground of rejection. The first two paragraphs (pages 4-5) of this summary appear to be identical to the first two paragraphs of the rejection as stated in item no. 2 (pages 3-5) of Office action of November 3, 2005.

However, Appellant notes that the third paragraph of this summary (page 5, last paragraph, to page 6) is **modified** from the third paragraph in item no. 2 (page 5) of the Office action of November 3, 2005. In particular, the Examiner replaces the original text: "since fluororesins are known in the fuel hose art to possess inadequate adhesiveness to polyamide and polyester, as taught by Nishi et al." with --since adding a functional group to the fluororesin increases the adhesive bond between the fluororesin and the polyester and polyamide of the adhesive layer, as taught by Nishi et al., thus improving the adhesiveness between the fluororesin and the adhesive layer of Nishino et al.-- This is new text, not found in the final Office action of March 13, 2006.

Appellant argues below that this change in text of the rejection represents a significant change in the presentation of the rejection, since this deals with the exact nature of the proposed modification and the motivation for the modification. Appellant also notes that the modified portion of the rejection was, in fact, **highlighted in bold and discussed in Appellant's remarks on page 11 of the Appeal Brief**. The Examiner appears to be stating that the proposed modification is

U.S. Patent Application Serial No. **10/757,453**  
Reply Brief filed February 27, 2007  
Reply to OA dated January 10, 2007

“adding a functional group to the fluororesin,” that is, the innermost layer 10 of Nishino, with the motivation being to improve adhesiveness to the adhesive layer 11 of Nishino.

Heading (10): In the first two paragraphs on page 6 of the Examiner's answer, the Examiner briefly summarizes Appellant's arguments, noting that Appellant has correctly understood the Examiner's proposed modification of the references.

At the bottom of page 6, the Examiner responds to Appellant's general remarks regarding point (1) on page 12, middle paragraph, of the Appeal Brief, regarding whether there is “inadequate adhesiveness” in Nishino, stating:

“With regard to Appellant's point that Nishino et al. does not disclose or suggest that there is any lack of adhesiveness between the innermost and adhesive layers, the Examiner has not made the inference that there is “inadequate adhesiveness” between the innermost layer and adhesive layer of Nishino et al. The Examiner is extracting from Nishi et al. the teaching that fluororesin does not have adequate adhesiveness to nonfluorinated resins such as polyamide an polyester.”

Appellant notes that the phrase “inadequate adhesiveness” was found in the text of the original rejection (November 3, 2005), but, as discussed above, this phrase has been **deleted** in the Examiner's statement of the rejection in heading (9) of the Reply Brief.

Appellant therefore submits that the Examiner appears to be accepting Appellant's argument that the Examiner's “inadequate adhesiveness” argument was improper, and that there is no suggestion or motivation in **Nishino et al.** for the proposed modification of Nishino's innermost

U.S. Patent Application Serial No. 10/757,453  
Reply Brief filed February 27, 2007  
Reply to OA dated January 10, 2007

layer. This would leave only the question of whether there is any suggestion in **Nishi et al.** for the proposed modification of Nishino.

The Examiner states that: "The Examiner is extracting from Nishi et al. the teaching ..." On page 7 of the Reply Brief, the Examiner further states: "Nishi et al. is used as a teaching to show that bonding is improved between fluororesins and materials such as polyester and polyamide when a functional group is added."

However, Appellant argues that this "teaching" of Nishi does not, in itself, provide a suggestion that there was "inadequate adhesiveness" in Nishino, which provided the motivation in the original rejection. Again, the fact that the Examiner has dropped the phrase "inadequate adhesiveness" indicates that the Examiner accepts that this basis of the original rejection was, in fact, improper.

In the Examiner's arguments on pages 6-7 of the Reply Brief, the only apparent statement of a motivation for the proposed modification of the references is that:

"Therefore, by adding a functional group to the innermost layer of Nishino et al. there would be enhanced adhesion between the innermost layer and the polyamide and polyester components of the adhesive layer, thus leading to increased adhesion between the innermost layer and adhesive layers." (page 7, lines 15-19)

However, this statement represents only the **Examiner's technical analysis** of what would happen if the proposed modification were made. This is an unsupported technical opinion of the Examiner, and **is not, in fact, a citation of a suggestion or motivation** for this proposed modification in either cited reference. The Examiner still has not pointed out such a suggestion or

U.S. Patent Application Serial No. 10/757,453  
Reply Brief filed February 27, 2007  
Reply to OA dated January 10, 2007

motivation, and has not addressed either point (1) or (2) raised on page 12 of the Appeal Brief. The Examiner therefore still has failed to provide a *prima facie* case of obviousness.

At the bottom of page 7, the Examiner appears to respond to Appellant's remarks on page 15 of the Appeal Brief, that there is no suggestion or motivation to combine the references. The Examiner now states that Nishi et al. provides the suggestion or motivation, again referring to the "teach[ing] that adhesion between fluororesins and non-fluororesins such as polyester and polyamide is improved when a functional group is added to the fluororesin." The Examiner states:

"Because the adhesive layer of Nishino et al. includes a polyester and polyamide, it would have been obvious to one having ordinary skill in the art that the bond between the innermost layer and the adhesive layer would be strengthened if the innermost layer was adhesive to not only the fluororesin component of the adhesive layer but also the polyester and polyamide components by adding the functional group to the fluororesin of the innermost layer." (page 8, lines 2-12)

Appellant responds by arguing that this sentence states broadly that "it would have been obvious" **without pointing out a suggestion or motivation in the references** for the proposed modification. This sentence, in fact, appears to be only a reiteration of the Examiner's technical opinion that, if the proposed modification were made, there would be a better bond between Nishino's innermost layer and adhesive layer.

The Examiner then states:

"Thus, the motivation to increase the adhesiveness of the layers of Nishino et al, suggest [sic] the combination of Nishino et al. and Nishi et al."

Appellant argues that this sentence is apparently a *non sequitur*. In a *prima facie* case of obviousness, there must be a teaching, suggestion or motivation in the cited references or the general

U.S. Patent Application Serial No. 10/757,453  
Reply Brief filed February 27, 2007  
Reply to OA dated January 10, 2007

art, for the proposed modification. It is meaningless to state that a “motivation” “suggests” anything. Moreover, the source of the “motivation” referred to is completely unclear.

Finally, in the last paragraph on page 8, with regard to Appellant's “teaching away” argument on pages 15-16 of the Appeal Brief, the Examiner states:

“... Nishi et al. teach that by adding a functional group to the fluororesin there can be adequate adhesion between the fluororesin layer and a non-fluorinated layer without an intermediate adhesive layer. However, Nishi et al. does not teach that the invention would not function with an intermediate adhesive layer, only that the adhesive layer is not necessary.”

However, Appellant **did not argue** that Nishi teaches that the “invention would not function with an intermediate adhesive layer.” This is a misstatement of Appellant's argument. Appellant argued that Nishi and Nishino teach mutually exclusive solutions, and that the references therefore do not suggest any modification of each other (Appeal Brief, page 16, second paragraph). The Examiner's statement here improperly summarizes Appellant's argument and ignores the argument made.

In summary, Appellant submits that the Examiner's change in the text of the stated rejection in the Examiner's Answer indicates that the Examiner has accepted Appellant's argument that at least one aspect of the originally stated rejection was improper. In addition, the arguments in the Examiner's answer are based in part on the Examiner's own opinion as to what would happen if the proposed modification were made, and this opinion is used in a hindsight manner as a motivation to modify the reference, without any citation of such a suggestion or motivation in the references. Appellant maintains that there is no such suggestion or motivation in the references. In addition,

U.S. Patent Application Serial No. 10/757,453  
Reply Brief filed February 27, 2007  
Reply to OA dated January 10, 2007

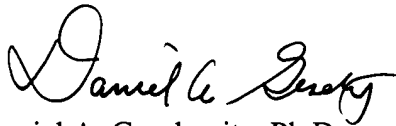
Appellant's argument regarding the teachings of the two references being mutually exclusive has been misstated by the Examiner, and has not been addressed in the Examiner's Answer.

Appellant therefore maintains the arguments presented in the Appeal Brief, and submits that none of those arguments has been successfully rebutted by the Examiner. Withdrawal of the rejections and allowance of the pending claims are therefore again respectfully requested.

In the event that this paper is not timely filed, the Appellant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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